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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,734	03/01/2002	Hiroki Shiomi	220117US3	8413

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ALEXANDRIA, VA 22314

EXAMINER

CULBRETH, ERIC D

ART UNIT	PAPER NUMBER
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3616

DATE MAILED: 01/14/2004 //

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/085,734

Applicant(s)

SHIOMI ET AL.

Examiner

Eric D Culbreth

Art Unit

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The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 13, 14, 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-12, 15-17 and 20-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 6, 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 1-8, 13-14, and 18-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 10.

2. Applicant's election with traverse of Figure 11 in Paper No. 10 is acknowledged. The traversal is on the ground(s) that any appropriate search for the elected species will also require a search through the appropriate classes and subclasses for the other species and that hence it would not constitute a significant additional burden on the Office to examine all of the species. This is not found persuasive because the search for the various species may not necessarily require a search of the same classes and subclasses as different structure is claimed for each species, and because it would be an undue burden on the examiner to locate and apply art to the structure of the various species.

The requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

3. Japanese Patent Abstract 04302770 was filed with Paper No. 6 (August 28, 2002) but was not listed on the form PTO-1449. It is listed on the enclosed PTO-892.

4. Japanese Patent 63-37729 filed with Paper No. 4 (3/1/02) has an incorrect English abstract (the English abstract is for a different document).

5. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892 or initialed by the examiner on a form PTO-1449, they have not been considered.

This refers to the references cited on pages 1-2 of the specification.

Drawings

6. The drawings are objected to because of the following informalities. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

- a. In Figure 2 and the remainder of the drawings, reference numeral 28 should not be underlined, as underlining indicates the numeral rests on the part to which it refers.
- b. In Figure 9(a), reference numeral 110 should not be underlined.
- c. On page 35, line 29 "13" should apparently be "t13".
- d. On page 42, line 16, "155" should be "115".

Specification

7. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

8. The disclosure was amended by informal examiner's amendment to correct the following informalities:

- a. On page 7, line 21 "Four" was changed to "four".
- b. On page 18, line 2, "off" was changed to "out of".
- c. On page 40, line 15, "receive" was changed to "receives".

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 9-12, 15-17 and 20-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 9, line 3 there is no antecedent basis for "the actual gear ranges". Note also claims 15, 20 and 22-24.

In claim 9, line 16 there is no clear antecedent basis for "the detection signal" (detection signals were previously recited). The same occurs in claims 15, 20 and 22-24.

In claim 9, line 18 “allows to indicate” is not clear because it is awkward grammar. The same wording occurs in claim 10. Note also claims 15-16 and 22-24.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 9-10, 12, 15-17 and 20-24 as best understood are rejected under 35 U.S.C. 102(b) as being anticipated by Morrell et al (U.S. Patent 4,892,014, cited by applicant).

Regarding claims 9, 15, 20 and 22-23, at column 6, lines 3-32 Morrell et al discloses a gear range shifting mechanism (valve 32) that mechanically shifts the gear ranges, actuator or selector switch 14 that operates valve 32, range detecting means (the buttons on selector switch 14 for setting the target range), actual range detector or sensor 56 sensing the position of the valve, and a controller 10 for shifting the actual gear ranges based on the actual gear ranges and the manipulation ranges set by the driver. As noted at column 6, lines 22-26 the manipulation range is indicated based on a detection signal as indefinitely recited so as to indicate that the manipulation range does not correspond to the manipulation range detecting means (i.e., display 17 gives a reason that the shift was not performed or prohibited as per claims 12 and 17).

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Regarding claims 20-21 and 24, the display 17 indicates the actual gear range detected at column 16, lines 22-24, and a manipulation member is automatically restored to a position before being manipulated by a driver (column 16, lines 27-31, where the system is moved to park).

Allowable Subject Matter

13. Claim 11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

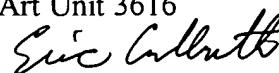
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric D Culbreth whose telephone number is 703/308-0360. The examiner can normally be reached on Monday-Thursday, 9:30-7:00 alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Dickson can be reached on 703-308-2089. The fax phone number for the organization where this application or proceeding is assigned is 703/746-3508.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Eric D Culbreth
Primary Examiner
Art Unit 3616



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